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Supreme Court of the United States

OCTOBER TERM, 1959

No. 214

MILLER MUSIC CORPORATION, PETITIONER,

vs.

CHARLES N. DANIELS, INC.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

PETITION FOR CERTIORARI FILED JULY 16, 1959
CERTIORARI GRANTED OCTOBER 12, 1959

SUPREME COURT OF THE UNITED STATES

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[fol. 1]

**IN UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT**

MILLER MUSIC CORPORATION, Plaintiff-Appellant,

against

CHARLES N. DANIELS, INC., Defendant-Appellee.

STATEMENT UNDER RULE 15 (b)

This suit was commenced by the filing of the complaint on June 29, 1954. The names of the original parties appear in the above caption. The answer of the defendant was filed on July 20, 1954. The defendant was not arrested, no bail was taken, and its property was not attached.

On April 10, 1957, the plaintiff made a motion, pursuant to Rule 56, F.R.C.P., for summary judgment as prayed for in the complaint and dismissing the counterclaims in defendant's answer. On April 18, 1957, the defendant made a cross motion, pursuant to Rule 56, F.R.C.P., for summary judgment dismissing the complaint. On January 4, 1958, the Honorable Frederick von Pelt Bryan, District Judge, filed his opinion denying plaintiff's motion and granting defendant's motion, and pursuant thereto judgment was entered on February 28, 1958 dismissing the complaint.

Plaintiff's notice of appeal was filed on March 11, 1958, the posting of a bond having been waived by defendant as provided in the judgment.

The plaintiff appeared by Abeles & Bernstein. The defendant originally appeared by Lee V. Eastman. Lewis A. Dreyer and Jack M. Ginsberg were substituted as attorneys for defendant pursuant to an order entered on April 5, 1957.

[fol. 2]

**Appendix to Appellant's Brief for the
Southern District of New York**

IN UNITED STATES DISTRICT COURT

COMPLAINT—filed June 29, 1954

Plaintiff, by its attorneys, Abeles & Bernstein, respectfully alleges:

1. The action arises under the Act of March 4, 1909, c. 320, 35 Stat. 1075 *et seq.*, U.S.C. Title 17, and the amendments thereto, as codified and enacted into positive law by the Act of July 30, 1947, c. 391, 61 Stat. 652, and the amendments thereto, and the Act of June 25, 1948, c. 646, 62 Stat. 931, U.S.C. Title 28, Sec. 1338, as hereinafter more fully appears.

2. Plaintiff and defendant are corporations incorporated under the laws of the State of New York.

3. Prior to January 10, 1925, Ben Black and Charles Neil Daniels, also known as Neil Moret, each of whom then was and during his lifetime continued to be a citizen of the United States, created and wrote an original musical composition entitled "MOONLIGHT AND ROSES (BRING MEM'RIES OF YOU)."

4. This musical composition, the music of which was in part adapted from a musical work entitled "Andantino In D Flat," with the consent of the proprietor of the then copyright therein, contains a large amount of material wholly original with said Ben Black and Charles Neil Daniels and is copyrightable subject matter under the laws of the United States.

5. Prior to January 10, 1925, said Ben Black and Charles Neil Daniels duly assigned to Villa Moret, Inc., a music publisher, said musical composition and the right to secure copyright thereof in its name.

[fol. 3] 6. Between January 9, 1925 and January 16, 1925, said Villa Moret, Inc. duly complied in all respects with all

laws of the United States governing copyright then in force, and secured the exclusive rights and privileges in and to the copyright of said musical composition, and received from the Register of Copyrights a certificate of registration, dated and identified as follows: "Jan. 10, 1925, Class Exxxc No. 605065."

7. From January 10, 1925, and for the balance of the original term of copyright therein, said musical composition was published by or under the authority of said Villa Moret, Inc. and all copies of it made by said Villa Moret, Inc. or under its authority or license were printed, published and offered for sale in strict conformity with the provisions of all laws of the United States governing copyright then in force.

8. For a valuable consideration, by an instrument in writing dated and executed in the United States on October 14, 1946 and duly recorded in the Copyright Office of the United States on October 27, 1946, said Ben Black duly assigned to plaintiff all his rights, title and interest in and to all renewal copyrights in said musical composition, and covenanted, undertook and agreed to make and execute any and all further instruments, documents and writings for the purpose of perfecting and conforming such rights, title and interest in plaintiff.

9. Said Ben Black died in the State of California on December 26, 1950, being more than one year prior to the expiration of the original term of copyright in said musical composition, leaving no widow or children, and pursuant to said instrument of October 14, 1946 bequeathed by will the right of his brother David Black and the Bank of America, National Trust And Savings Association, as co-[fol. 4] executors to apply for the renewal of said copyright in said musical composition for and on behalf of plaintiff.

10. The said Bank of America, National Trust And Savings Association, having renounced its right to act as co-executor of said will, the said David Black qualified in the State of California as the sole executor thereof.

11. The original and renewal term of copyright, in said musical work entitled "Andantino In D Flat," expired prior to January 9, 1953.

12. The original term of copyright in said musical composition entitled "MOONLIGHT AND ROSES (BRING MEMORIES OF YOU)" expiring on January 9, 1953, said David Black as the executor of said will, became entitled to and secured for and on behalf of plaintiff the rights, title and interest through said Ben Black as a co-writer of said musical composition in and to the renewal and extension of the copyright therein for a further term of twenty-eight years, by complying with all laws of the United States governing copyright then in force, including the making of application therefor to the Copyright office and registering the same therein on January 16, 1952, being within one year prior to the expiration of the original term of copyright therein, and received from the Register of Copyrights a certificate of registration dated and identified as follows: "Jan. 16, 1952, Class R No. 88745."

13. Since January 16, 1952, plaintiff has been and still is the sole owner and proprietor of all rights, title and interest through said Ben Black in and to the said renewal copyright in said musical composition.

14. Continuously, since in or about the month of February, 1953, defendant has claimed and asserted that, by [fol. 5] virtue of a purported assignment from said David Black as the executor of said will, made subsequent to January 16, 1952, it is the sole owner and proprietor of all rights, title and interest through said Ben Black in and to the said renewal copyright in said musical composition, and that plaintiff is not possessed of any rights, title or interest whatsoever therein or thereto.

15. Defendant, acting under the said purported assignment, has made and continues to make such claim and assertion to the public, the trade, potential users and licensees, and certain agents and agencies through whom and which music publishers, including plaintiff and defendant, exercise rights and grant licenses to their musical compositions, and that defendant is thereby solely and exclu-

sively entitled to exercise all rights and grant all licenses in respect to all rights, title and interest through said Ben Black in and to said renewal copyright and to the payment of all royalties and fees accruing therefrom, and that plaintiff is not possessed of any rights, title or interest whatsoever therein or thereto.

16. Defendant has thereby prevented plaintiff from exercising and licensing such rights, has deprived plaintiff of all rights, title and interest through said Ben Black in and to said renewal copyright, and has thereby infringed and destroyed the rights, title and interest of plaintiff through said Ben Black in and to said renewal copyright.

17. A copy of said copyrighted musical composition is hereto annexed as "Exhibit A."

18. Plaintiff has notified defendant that defendant has thereby infringed and destroyed the rights, title and interest of plaintiff through said Ben Black in said musical copyright, and defendant has continued such acts on its part.

[fol. 6] Wherefore, plaintiff demands:

(1) That defendant, its agents, and servants be enjoined during the pendency of this action and permanently (a) from infringing and destroying the rights, title and interest of plaintiff through said Ben Black in said renewal copyright in any manner, and (b) from asserting and claiming that defendant is the owner or proprietor of any rights, title or interest through said Ben Black in said renewal copyright, and from exercising any rights or granting any licenses in respect to any such rights, title or interest.

(2) That defendant assign to plaintiff the rights, title and interest through said Ben Black in said renewal copyright, allegedly acquired by defendant under the said purported assignment from said David Black as the executor of the will of said Ben Black.

(3) That defendant be required to pay to plaintiff such damages as plaintiff has sustained in consequence of defendant's infringement and destruction of the rights, title

and interest of plaintiff through said Ben Black in said renewal copyright and to account for all gains, profits and advantages derived by defendant by its infringement and destruction of the rights, title and interest of plaintiff through said Ben Black in said renewal copyright or such damages as to the Court shall appear proper within the provisions of the copyright statutes, but not less than two hundred and fifty dollars.

(4) That defendant pay to plaintiff the costs of this action and reasonable attorneys' fees to be allowed to the plaintiff by the Court.

(5) That plaintiff have such other and further relief as is just.

[fol. 7]

NOTE RE: EXHIBIT A, ANNEXED TO COMPLAINT

COPY OF MUSICAL COMPOSITIONS

IN UNITED STATES DISTRICT COURT

AGREED STATEMENT OF FACTS AND CONCLUSIONS OF LAW—
March 18, 1957

The attorneys for the respective parties hereby stipulate and agree that the following facts and conclusions of law are admitted for all purposes of this action:

1. The action arises under the Act of March 4, 1909, c. 320, 35 Stat. 1075 *et seq.*, U.S.C. Title 17, and the amendments thereto, as codified and enacted into positive law by the Act of July 30, 1947, c. 391, 61 Stat. 632, and the amendments thereto, and the Act of June 25, 1948, c. 646, 62 Stat. 931, U.S.C. Title 28, Sec. 1338.

2. Plaintiff and defendant are New York corporations each of which is in business as a music publisher.

3. Prior to January 10, 1925, Ben Black (hereinafter referred to as "Decedent") and Charles Neil Daniels (also known as Neil Moret), both of whom then were and during their respective lifetimes continued to be citizens of the United States, wrote an original musical composition en-

titled "MOONLIGHT AND ROSES (BRING MEM'RIES OF YOU)" (hereinafter referred to as "Said Composition").

4. The music of Said Composition was in part adapted from a work entitled "Andantino in D Flat," with the consent of the owner of the then copyright therein, but contains a large amount of material wholly original with Decedent [fol. 8] and Charles Neil Daniels, and was and is copyrightable subject matter under the laws of the United States.

5. Prior to January 10, 1925, Decedent and said Charles Neil Daniels duly assigned to Villa Moret, Inc., a music publisher, Said Composition and the right to secure copyright therein in its name.

6. Between January 9, 1925 and January 16, 1925, said Villa Moret, Inc. duly complied in all respects with all laws of the United States governing copyright then in force, and secured the exclusive rights and privileges in and to copyright of Said Composition, and received from the Register of Copyrights a certificate of registration, dated and identified as follows: "Jan. 10, 1925, Class Exxx No. 555065."

7. From January 10, 1925, and for the balance of the original term of copyright therein, expiring January 9, 1953, Said Composition was published by or under the authority of said Villa Moret, Inc. and all copies of it made by said Villa Moret, Inc. or under its authority or license were printed, published and offered for sale in strict conformity with the provisions of all laws of the United States governing copyright then in force.

8. Under date of October 3, 1946, Decedent entered into a written agreement with plaintiff, a copy of which is annexed hereto as "Exhibit A" and made a part hereof. Under said agreement, among other things, Decedent assigned to plaintiff all Decedent's rights and interests, then or thereafter in existence, in the renewal and extension of the United States copyright in Said Composition, and in consideration of acquiring said rights and interests plaintiff agreed to pay Decedent certain royalties and the sum of \$1,000.00 on account and in advance of said royalty payments.

[fol. 9] 9. Said sum of \$1,000.00 was actually paid to Decedent by plaintiff upon the signing of said agreement "Exhibit A," annexed.

10. On October 14, 1946, Decedent and Decedent's brothers David Black, Jules Black and Isidore Black, each executed separate instruments, copies of which are annexed hereto as "Exhibit A-1," "Exhibit A-2," "Exhibit A-3" and "Exhibit A-4" and made a part hereof, whereunder each on behalf of himself and all other parties in interest assigned to plaintiff all rights and interests whatsoever, then or thereafter in existence, in the renewal and extension of the United States copyright in Said Composition. In said assignments each of said assignors further covenanted to make and execute any and all further instruments, documents and writings for the purpose of perfecting and confirming such rights and interests in plaintiff. Said instruments of assignment were made and delivered pursuant to, and as part of, said agreement "Exhibit A," annexed.

11. Said five instruments, "Exhibit A," "Exhibit A-1," "Exhibit A-2," "Exhibit A-3" and "Exhibit A-4" annexed, were duly recorded in the Copyright Office on October 27, 1946.

12. Und. date of June 1, 1950, Decedent made a will a copy of which is annexed hereto as "Exhibit B" and made a part hereof.

13. Decedent died in the State of California on December 26, 1950, leaving no widow or children. His said will, "Exhibit B" annexed, was duly admitted to probate in the Superior Court of the State of California on February 15, 1951.

14. Said will, "Exhibit B" annexed, named Decedent's brother, David Black (one of the assignors referred to in [fol. 10] paragraph "10" of this stipulation) and The Bank of America, National Trust and Savings Association, as co-executors of said will. The Bank of America, National Trust and Savings Association, renounced its right to act as co-executor, and David Black qualified as the sole executor of Decedent's said will.

15. On January 16, 1952, within one year prior to the expiration of the original term of copyright in Said Composition, David Black, as sole executor of Decedent's estate, applied to the Copyright Office for the renewal and extension of the copyright therein and received from the Register of Copyrights a certificate of registration of said application for renewal, dated and identified as follows: "Jan. 16, 1952, Class R No. 88745," a copy of which is annexed hereto as "Exhibit C" and made a part hereof.

16. On March 24, 1952, final distribution of all property whatsoever in the estate of Ben Black was decreed by the Superior Court of the State of California. A copy of such decree of said Court for final distribution is annexed hereto as "Exhibit D" and made a part hereof.

17. The original term of the copyright in Said Composition expired on January 9, 1953, more than one year following the death of Decedent.

18. The renewal term of copyright in the said musical composition entitled "Andantino in D Flat" had expired prior to January 9, 1953.

19. Under date of May 1, 1952, defendant entered into an agreement with certain nephews and nieces of Decedent. A copy of said agreement as filed in the Copyright Office April 15, 1953 is annexed hereto as "Exhibit E" and made a part hereof and a copy of said agreement as filed in the Copyright Office January 18, 1954 is annexed hereto as "Exhibit E-1" and made a part hereof. In said agreement, among other things, said nephews and nieces of Decedent [fol. 11] assigned to defendant all their right, title and interest in Said Composition. Upon the petition of David Black as executor of Decedent's estate said agreement between defendant and said nephews and nieces of Decedent was approved by order of the Superior Court of the State of California dated June 23, 1952, copy of which is annexed hereto as "Exhibit F" and made a part hereof. As submitted to the Superior Court for approval said agreement was not signed by said executor.

20. On May 6, 1947, defendant entered into an agreement with Neil M. Daniels and Tholen D. Garrett, children

of Charles Neil Daniels (also known as Neil Moret), the co-author of Said Composition. A copy of said agreement is annexed hereto as "Exhibit G" and made a part hereof. Attached hereto as "Exhibit G-1" is copy of assignment from the said Daniels and Garrett to defendant, filed in Copyright Office, Vol. 639, page 98.

21. The said Neil M. Daniels and Tholen D. Garrett applied to the Register of Copyrights for the renewal and extension of the copyright in Said Composition and received from the Register of Copyrights a certificate of registration of said application for renewal, dated and identified as follows: "Jan. 21, 1952, Class R No. 9037," a copy of which is annexed hereto as "Exhibit H" and made a part hereof.

22. Plaintiff claims that it is the sole owner and proprietor of all rights, title and interest through Decedent in and to the United States renewal copyright in Said Composition.

23. Defendant claims that it is the sole owner of the United States renewal copyright in Said Composition by having acquired the right, title and interest therein of (a) the executor and residuary legatees of Decedent's estate, and (b) the children of Charles Neil Daniels, the co-author of said Composition.

[fol. 12] 24. Defendant has made such claim, and the claim that plaintiff has no right, title or interest whatsoever in the renewal copyright in Said Composition to potential users and licensees and to certain agents and agencies through whom music publishers exercise rights and grant licenses to their musical compositions, thereby preventing plaintiff from exercising and licensing such rights and depriving plaintiff of all rights, title and interest through said Ben Black in and to said renewal copyright.

25. Plaintiff has notified defendant that defendant has infringed and destroyed its said rights and interests and defendant has continued its acts.

26. On the hearing of the motion for summary judgment in this matter the following original and/or certified copies of documents will be handed up to the Court:

(a) Renewal registration of "MOONLIGHT AND ROSES," No. R 88745, dated January 16, 1952, claimed on behalf of David Black; Executor of the Estate of Ben Black ("Exhibit C");

(b) Renewal registration of "MOONLIGHT AND ROSES," No. R 90371, dated January 21, 1952, claimed by Neil M. Daniels and Tholen D. Garrett, as children of Neil Moret;

(c) Exemplified copy of proceedings in the matter of the Estate of Ben Black (also known as Bernard Black), Deceased, in the Superior Court of the State of California, in and for the City and County of San Francisco.

Dated: New York, N. Y.
March 18, 1957.

ABELES & BERNSTEIN,
Attorneys for Plaintiff

LEWIS A. DREYER &
JACK M. GINSBERG
Attorneys for Defendant

[fol. 13]

EXHIBIT A, ANNEXED TO AGREED STATEMENT

FOR AND IN CONSIDERATION of One Dollar and other good and valuable considerations paid by MILLER MUSIC CORPORATION (formerly Miller Music, Inc.) (hereinafter referred to as "Miller"), to BEN BLACK (hereinafter referred to as "Black"), receipt whereof is hereby acknowledged, and of the premises, Black hereby bargains, sells, transfers, assigns and sets over to Miller; everywhere, forever and without limitation, any and all rights and interests whatsoever, now or at any time or times hereafter known or in existence, now possessed or which may at any time or times hereafter be acquired or possessed by Black, in or to the following entitled musical compositions:

(Titles of Musical Compositions)

and in or to any and all adaptations, arrangements, translations and versions thereof, and including among all other

things and without limitation, any and all rights and interests in and to any and all original copyrights therein and all renewals and extensions thereof and for and during every period in respect of which copyrights may subsist beyond the original terms thereof, throughout the world (all of the foregoing being hereinafter referred to as "said compositions"), together with the right, power and authority to make any versions, omissions, additions, changes, substitutions, adaptations, arrangements, dramatizations and translations of in and to said compositions and the titles, words and music thereof.

In consideration of Miller acquiring the rights to said compositions as in this instrument provided, Miller will pay or cause to be paid to Black during the respective periods of all renewals and extensions of the copyrights in each of said compositions, the following compensation as royalties and fees, provided, however, that as to each of said compositions as to which Black is not the sole writer [fol. 14] and composer, then Miller will pay Black only a proportionate share thereof in proportion to the total number of writers and composers (irrespective of whether or not Miller has acquired or may acquire their rights and interests therein) i.e., one-half if there are two writers and composers, one-third if there are three writers and composers, and one-fourth if there are four writers and composers:

3¢ for each regular piano copy and for each orchestration of said compositions sold by Miller, paid for and not returned in the United States of America and the Dominion of Canada;

50% of all net moneys received by Miller in respect of any licenses issued authorizing the manufacture of parts of instruments serving to mechanically reproduce said compositions or to use said compositions in television or in synchronization in sound motion pictures or to reproduce the same upon so-called electrical transcription for broadcasting purposes; and of any and all receipts of Miller from any other source or right now known or which may hereafter come into existence for

which specific provision for payment is not made in this instrument, except from rights of public performance and broadcasting;

\$25. for the use of said compositions in each folio or composite work, sold by Miller, paid for and not returned in the United States of America and the Dominion of Canada, in lieu of any other payment therefor; and

50% of all moneys received by Miller in respect of regular piano copies and/or orchestrations thereof and in respect of the use of said compositions in any folio or composite work, sold and paid for in any foreign country.

[fol. 15] Anything to the contrary notwithstanding, payment by Miller or any of its successors or assigns to all such other writers and composers of said compositions shall be conditioned upon Miller or its successors or assigns having acquired or acquiring their respective interests in said compositions for the renewal periods of copyright, the amount of all such payments to be the amount, if any, specified in the respective instruments under which such rights were or are acquired by Miller or its successors or assigns.

In further consideration of Miller acquiring the rights to said compositions as in this instrument provided, free and clear of all claims and encumbrances, Miller has paid to Black upon the execution of this instrument, the sum of \$1000.00, receipt whereof is hereby acknowledged, which shall be on account and in advance of all royalties and fees whatsoever to become payable by Miller, its successors and assigns, to Black in respect of said compositions. Miller or its successors or assigns shall not be obligated for the payment of any further moneys in respect to said compositions until it shall have first recouped said advance payment of \$1000.00 from such royalties and fees.

During such period as moneys may accrue to Black under this agreement, Miller shall render itemized statements and make payment to Black of such moneys (after the advance payment of \$1000.00 shall have been earned and recouped) within forty-five days after June 30th and

December 31st of each year for the preceding semi-annual periods. Black or his representative may appoint a certified public accountant who shall at any time during usual business hours have access to all records of Miller relating to said compositions for the purpose of verifying royalty statements rendered or which are delinquent under the terms hereof.

In all respects this agreement shall be subject to any existing agreements between both of the parties hereto and the American Society of Composers, Authors and Publishers.

[fol. 16] Miller shall have the right to grant, license, transfer, assign, sell and dispose of any and all rights under this instrument. Black covenants, undertakes and agrees, to make, execute and deliver any and all further instruments, documents and writings that may be requested by Miller, its successors and assigns, for the purpose of perfecting and confirming in Miller the rights and interests in all renewals and extensions of the copyrights in said compositions, vested by Black in Miller under this agreement, and Black hereby nominates and appoints Miller and its each and every successor and assign, the true and lawful attorney of Black to make, execute and deliver any and all such instruments, documents and writings in the name of Black, and to renew and extend the copyrights in said compositions and to make application therefor in the name of Black or Miller or otherwise as in every such case made and provided, for and on behalf of Miller and its successors and assigns as the real party in interest therein.

As an inducement to Miller to pay the consideration provided and to exercise the rights under this instrument, Black warrants and represents: That he and only such co-writers and composers as hereinbefore set forth are the sole writers and composers of said compositions; that he has the right to renew and extend the copyrights in said compositions, numbers, works or material, and that said compositions are not in the public domain; that he has never bargained, sold, assigned, transferred, hypothecated, pledged or encumbered any right, title or interest in or to the renewal copyrights in any of said compositions, or the right of renewal or extension thereof. Black makes no

warranty or representation as to the rights of any other writers or composers of said compositions.

IN WITNESS WHEREOF, the said Ben Black has executed this instrument this 3rd day of October, 1946.

BEN BLACK (L.S.)

Confirmed:

MILLER MUSIC CORPORATION

By Abe Olman

[fol. 17]

EXHIBIT A-1, ANNEXED TO AGREED STATEMENT

For and in consideration of One Dollar and other good and valuable considerations in hand paid, receipt whereof is hereby acknowledged, BEN BLACK, for and on behalf of himself and all other parties in interest hereby transfers, assigns and sets over to MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), subject to the terms, covenants and conditions as set forth in an agreement between BEN BLACK and MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), dated October 3, 1946, all rights whatsoever in and to the musical compositions entitled:

(Titles of musical compositions)

under all renewals and extensions of the copyright thereof and in and to the renewals and extensions of the copyright therein, and for and during such time or times copyright may subsist beyond the first period of time (as then provided by law) for which copyright was originally acquired in said compositions, together with all rights and interests in and to all of the foregoing now or at any time or times hereafter known or in existence.

IN WITNESS WHEREOF, the said BEN BLACK has executed this instrument and affixed his seal this 14 day of October, 1946.

BEN BLACK (L.S.)

EXHIBIT A-2, ANNEXED TO AGREED STATEMENT

For and in consideration of One Dollar and other good and valuable considerations in hand paid, receipt whereof is hereby acknowledged, DAVID BLACK, for and on behalf of himself and all other parties in interest hereby transfers, assigns and sets over to MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), subject to the terms, covenants and conditions as set forth in an agreement between BEN BLACK and MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), dated October 3, 1946, all rights whatsoever in and to the musical compositions entitled:

(Titles of musical compositions)

under all renewals and extensions of the copyright thereof and in and to the renewals and extensions of the copyright therein, and for and during such time or times copyright may subsist beyond the first period of time (as then provided by law) for which copyright was originally acquired in said compositions, together with all rights and interests in and to all of the foregoing now or at any time or times hereafter known or in existence.

The said David Black covenants, undertakes and agrees to make, execute and deliver any and all further instruments, documents and writings that may be requested by Miller Music Corporation (formerly Miller Music, Inc.), and its successors, assigns and licensees; for the purpose of perfecting and confirming any and all rights vested in it hereunder, and he hereby nominates and appoints Miller Music Corporation (formerly Miller Music, Inc.), and its each and every successor and assign, his true and lawful attorney, to make, execute and deliver in his name, all such instruments, documents and writings, and to renew and extend the copyrights in said compositions and to make application therefor in his name or Miller or otherwise as in every such case made and provided, for and on behalf of Miller or its successors or assigns as the real party in interest, this power being coupled with an interest and irrevocable for any cause or in any event whatsoever.

IN WITNESS WHEREOF, the said David Black has executed this instrument and affixed his seal this 14 day of October, 1946.

DAVID BLACK (L.S.)

[fol. 19]

EXHIBIT A-3, ANNEXED TO AGREED STATEMENT

For and in consideration of One Dollar and other good and valuable considerations in hand paid, receipt whereof is hereby acknowledged, JULES BLACK, for and on behalf of himself and all other parties in interest hereby transfers, assigns and sets over to MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), subject to the terms, covenants and conditions as set forth in an agreement between BEN BLACK and MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), dated October 3, 1946, all right whatsoever in and to the musical compositions entitled:

(Titles of musical compositions).

under all renewals and extensions of the copyright thereof and in and to the renewals and extensions of the copyright therein, and for and during such time or times copyright may subsist beyond the first period of time (as then provided by law) for which copyright was originally acquired in said compositions, together with all rights and interests in and to all of the foregoing now or at any time or times hereafter known or in existence.

The said Jules Black covenants, undertakes and agrees to make, execute and deliver any and all further instruments, documents and writings that may be requested by Miller Music Corporation (formerly Miller Music, Inc.), and its successors, assigns and licensees, for the purpose of perfecting and confirming any and all rights vested in it hereunder, and he hereby nominates and appoints Miller Music Corporation (formerly Miller Music, Inc.), and its each and every successor and assign, his true and lawful attorney, to make, execute and deliver in his name, all such instruments, documents and writings, and to renew and

extend the copyrights in said compositions and to make application therefor in his name or Miller or otherwise as in every such case made and provided, for and on behalf [fol. 20] of Miller or its successors or assigns as the real party in interest, this power being coupled with an interest irrevocable for any cause or in any event whatsoever.

IN WITNESS WHEREOF, the said Jules Black has executed this instrument and affixed his seal this 14 day of October, 1946.

JULES BLACK (L.S.)

EXHIBIT A-4, ANNEXED TO AGREED STATEMENT

For and in consideration of One Dollar and other good and valuable considerations in hand paid, receipt whereof is hereby acknowledged, ISIDORE BLACK, for and on behalf of himself and all other parties in interest, hereby transfers, assigns and sets over to MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), subject to the terms, covenants and conditions as set forth in an agreement between BEN BLACK and MILLER MUSIC CORPORATION (formerly Miller Music, Inc.), dated October 3, 1946, all rights whatsoever in and to the musical compositions entitled:

(Titles of musical compositions)

under all renewals and extensions of the copyright thereof and in and to the renewals and extensions of the copyright therein, and for and during such time or times copyright may subsist beyond the first period of time (as then provided by law) for which copyright was originally acquired in said compositions, together with all rights and interests in and to all of the foregoing now or at any time or times hereafter known or in existence.

[fol. 21] The said Isidore Black covenants, undertakes and agrees to make, execute and deliver any and all further instruments, documents and writings that may be requested by Miller Music Corporation (formerly Miller Music, Inc.), and its successors, assigns and licensees, for the purpose of perfecting and confirming any and all rights vested in

it hereunder, and he hereby nominates and appoints Miller Music Corporation (formerly Miller Music, Inc.), and its each and every successor and assign, his true and lawful attorney, to make, execute and deliver in his name, all such instruments, documents and writings, and to renew and extend the copyrights in said compositions and to make application therefor in his name or Miller or otherwise as in every such case made and provided, for and on behalf of Miller or its successors or assigns as the real party in interest, this power being coupled with an interest and irrevocable for any cause or in any event whatsoever.

IN WITNESS WHEREOF, the said Isidore Black has executed this instrument and affixed his seal this 14 day of October, 1946.

ISIDORE BLACK (L.S.)

EXHIBIT B, ANNEXED TO AGREED STATEMENT

I, BEN BLACK, of 791 Lombard Street, San Francisco, California, do hereby make, publish and declare this my Last Will and Testament in manner and form as follows:

FIRST: I hereby revoke all former wills and codicils to wills by me made.

[fol. 22] SECOND: I hereby direct my executors hereinafter named to pay all my just debts and funeral expenses and proper claims and charges against my estate as soon after my demise as can lawfully and conveniently be done.

THIRD: I hereby declare that I am single and that I leave no issue surviving me, and that there is no child of mine now deceased leaving issue now surviving.

FOURTH: I hereby give and bequeath the following sums:

One Thousand Dollars (\$1,000.00) to my nephew, TEDDY BLACK of San Francisco, California, should he survive me, but should he predecease me; then this gift shall lapse.

One Thousand Dollars (\$1,000.00) to my nephew ROY BLACK of San Francisco, California, should he survive me, but should he predecease me the said sum hereby bequeathed shall go to his issue share and share alike.

FIFTH: The rest, residue and remainder of my estate of every nature, kind or description, real, personal or after acquired, I leave, equally to my following named nephews, and nieces, it being my express desire that in the event one of them shall predecease me the issue surviving such predeceased nephew or niece shall take the share of such predeceased nephew or niece. The names of my nephews and nieces among whom the rest, residue and remainder of my estate is to be divided are:

MRS. ESTELLE MOSK of San Francisco, California
 MRS. ABBY GITTLESOHN of San Francisco, California.
 MRS. CECILY PERAZZI of San Francisco
 DAVID BLACK of San Francisco, California and
 PHILLIP BLACK of San Francisco, California.

SIXTH: I do hereby nominate DAVID BLACK of San Francisco and the BANK OF AMERICA, NATIONAL TRUST AND SAV-
 [fol. 23] INGS. ASSOCIATION to be the Executors of this my Last Will and Testament. In the event that DAVID BLACK should refuse to act as such Executor, or for any reason become incapable of acting, then in his place and stead I direct that my brother, ISADORE, also known as "Zizz" BLACK, shall become Co-Executor with said Bank of America, and in the event that he shall refuse or become incapacitated to so act, then said Bank of American shall be the sole Executor of my estate.

SEVENTH: I do hereby expressly authorize and empower my said Executor to partition, improve, invest, reinvest, assign, transfer, pledge, mortgage, lease, exchange, sell, or otherwise dispose of any property of my estate, real or personal, at public or private sale, with or without notice as it may determine and without the order of any court, and to execute good and valid conveyances and transfers thereof. I further do hereby expressly authorize my Executors to operate and manage any business of which I may die possessed.

EIGHTH: I have purposely made no provision herein for any other person whether claiming to be an heir of mine or not and if any person should claim to be an heir of mine

and as such should assert claim to my estate or any part thereof, or should any person whether a beneficiary under this will or not mentioned herein contest this will or object to any of its provisions, then to such person or persons I hereby give and bequeath the sum of One Dollar (\$1.00) and no more in lieu of provisions which I have made or which I might have made herein for such person or persons.

IN WITNESS WHEREOF, I have hereunto set my hand and seal in the City and County of San Francisco, State of California, this 1st day of June, 1950.

BEN BLACK

[fol. 24]

NOTE RE: EXHIBIT C, ANNEXED TO AGREED STATEMENT

Certificate, dated January 16, 1952, of registration of renewal copyright by David Black as executor of the estate of Ben Black.

NOTE RE: EXHIBIT D, ANNEXED TO AGREED STATEMENT

Decree of the Superior Court of the State of California, dated March 24, 1952, settling accounts of executor, and for final distribution.

NOTE RE: EXHIBIT E, ANNEXED TO AGREED STATEMENT

Agreement, dated May 1, 1952, between the residuary legatees under the will of Ben Black and defendant.

NOTE RE: EXHIBIT E-1, ANNEXED TO AGREED STATEMENT

Copy of Exhibit E, as filed in the Copyright Office.

NOTE RE: EXHIBIT F, ANNEXED TO AGREED STATEMENT

Order of the Superior Court of the State of California, dated June 23, 1952, approving agreement of May 1, 1952.

[fol. 25]

NOTE RE: EXHIBIT G, ANNEXED TO AGREED STATEMENT

Agreement, dated May 6, 1947, between Neil M. Daniels and Tholen D. Garrett, children of co-author, and defendant.

NOTE RE: EXHIBIT G-1, ANNEXED TO AGREED STATEMENT

Assignment pursuant to Exhibit G.

NOTE RE: EXHIBIT H, ANNEXED TO AGREED STATEMENT

Certificate, dated January 21, 1952, of registration of renewal copyright by children of co-author.

IN UNITED STATES DISTRICT COURT

PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT

—Filed April 10, 1957

Plaintiff Miller Music Corporation moves the Court in the above-entitled cause as follows:

That it enter, pursuant to Rule 56 of the Federal Rules of Civil Procedure, summary judgment in favor of plaintiff as prayed for in the complaint and dismissing the counterclaim on the grounds that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

Dated, New York, N. Y.

April 3, 1957.

[fol. 26]

IN UNITED STATES DISTRICT COURT

DEFENDANT'S MOTION FOR SUMMARY JUDGMENT

—Filed April 18, 1957

Defendant moves the Court as follows:

1. That it enter, pursuant to Rule 56 of the Federal Rules of Civil Procedure, a summary judgment in defen-

dant's favor dismissing the complaint, on the ground that there is no genuine issue as to any material fact and that defendant is entitled to a judgment as a matter of law.

This motion is based upon:

- (a) The pleadings on file in this action;
- (b) The affidavit of Lewis A. Dreyer, sworn to the 15th day of April, 1957;
- (c) The stipulation of fact and Exhibits attached thereto, dated the 18th day of March, 1957.

IN UNITED STATES DISTRICT COURT

AFFIDAVIT IN OPPOSITION TO DEFENDANT'S MOTION

HERBERT N. GOTTLIEB, being duly sworn, deposes and says:

1. That for the past fifteen years he has been in the employ of plaintiff, Miller Music Corporation, as its office manager:

2. That during said period all process and notices served upon or received by plaintiff or which came to the attention of plaintiff in or concerning any actions or proceedings wherein or with respect to the subject matter of which, plaintiff might directly or indirectly be concerned or have any right or interest, have uniformly been referred to him.

[fol. 27] 3. That plaintiff was not served with and never received any process in, was not a party to, and had no notice or knowledge of, any proceedings whatsoever in the Superior Court of the State of California, in and for the City and County of San Francisco, in the Matter of the Estate of Ben Black, also known as Bernard Black, deceased.

(Sworn to June 20, 1957.)

IN UNITED STATES DISTRICT COURT

OPINION—December 31, 1957

BEVAN, District Judge:

This is an action for copyright infringement by one music publisher against another. Plaintiff claims to be the owner of a partial interest in the renewal copyright of the song "Moonlight and Roses," and seeks the enforcement of its rights as such owner. Defendant alleges that it is the owner of the entire copyright, including the partial interest claimed by plaintiff, and counterclaims for enforcement of its rights.

A United States copyright is valid for twenty-eight years from the date of first publication. 17 U.S.C., § 24. During the last year of the original twenty-eight year term an application for renewal for an additional twenty-eight years may be made under 17 U.S.C., § 24 by "the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin * * *."

The question presented here is whether the assignment of his renewal rights by Ben Black, one of the co-authors of the song, to plaintiff prior to the time when they accrued at the commencement of the last year of the original term of the copyright was defeated by the author's death before the period within which renewal could be commenced. There seem to be no reported cases which specifically pass on this question and it appears to be one of first impression.

In *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U. S. 643, the Supreme Court had before it for the first time the question of whether under the Copyright Act of 1909 an author may validly assign his renewal rights to a copyright prior to the time he actually acquires or may acquire them during the last year of the original copyright term. The court held that such an assignment was valid and binding as against the author or his subsequent assignees if the author survives until the twenty-eighth year

of the original copyright term, the year in which his renewal rights accrued. However, since the author was still alive at the time the renewal period commenced, *Fisher* left open the question presented here of whether such an assignment by the author could defeat the statutory right to renew which is expressly given to his widow and children, executor or next of kin by 17 U.S.C., § 24 if the author dies before the commencement of the twenty-eighth year of the original term.

The facts have been stipulated, and are as follows:

"Moonlight and Roses" was written by Ben Black and Charles N. Daniels some time prior to 1925. The authors assigned the composition and the right to secure a copyright therein to Villa Moret, Inc., a music publisher, and the latter obtained a copyright on January 10, 1925. This copyright expired on January 9, 1953.

On October 3, 1946 Ben Black assigned his partial interest in the renewal copyright to the plaintiff, Miller Music Corporation. The instrument of assignment did not by express language purport to bind Black's testamentary [fol. 29] representatives. The assignment included a power of attorney under which the plaintiff was authorized to file a renewal application in Ben Black's name. On October 14, 1946 the plaintiff obtained separate assignments from David, Jules and Isidore Black, brothers of Ben Black, of any respective interests which they might have in the renewal copyright. All the assignments contained covenants by the assignors to make and execute any and all further instruments, documents and writings for the purpose of perfecting and confirming all rights and interests in the renewal copyright in the plaintiff. Each was duly recorded in the Copyright Office on October 27, 1946.

Ben Black died, a resident of California, on December 26, 1950, before the commencement of the last year of the original copyright term when the right to apply for renewal first accrued. He left no surviving widow or children. In his will he names his brother David Black, and the Bank of America, as co-executors. The Bank failed to qualify and David Black became the sole executor.

The will, which was admitted to probate in the Superior Court of the State of California on February 15, 1951,

made no mention of the renewal copyright or of the 1946 assignment to plaintiff. The residuary estate was left to the testator's nephews and nieces, the children of various of his brothers.

On January 16, 1952, during the last year of the original copyright term, David Black, as executor of the estate of Ben Black, applied to the Copyright Office for the renewal of the copyright in "Moonlight and Roses" and received a certificate of renewal registration from the Register of Copyrights.

On March 24, 1952 the California Superior Court issued a decree ordering the distribution of all the property in the estate. The decree specified that all the rights in "Moonlight and Roses" were included in the distribution to the nephews and nieces as residuary legatees. The latter [fol. 30] assigned all their right, title and interest in the composition to the defendant by written assignment dated May 1, 1952. Upon petition of David Black as executor the assignment was approved by the Superior Court of California on June 23, 1952. Subsequently, a copy of the assignment, signed by David Black as executor, as well as by the assigning nephews and nieces, was filed with the Copyright Office.

The defendant has also acquired the renewal rights of the co-author, Charles N. Daniels, through an assignment from Daniels' children. There is no question as to the ownership of the Charles N. Daniels interest. The only dispute is as to who owns the Ben Black interest.

Plaintiff, asserting its partial ownership, demands that defendant be enjoined from infringing its rights under the copyright renewal; that defendant be compelled to assign to the plaintiff all the right, title and interest of author Ben Black which it claims; and that defendant be required to pay such damages as plaintiff has sustained and to account for all gains and profits derived by such infringement. Defendant counterclaims for substantially the same relief and demands, in addition, that plaintiff be required to deliver up for destruction all infringing copies and all plates, moulds and other matter used for making such infringing copies. Both sides have moved for summary judgment on the stipulated facts. The only question presented

is one of law as to the enforceability of the respective assignments under these circumstances.

Defendant's first contention is that the decree of final distribution by the California probate court is conclusive as to the ownership of the renewal copyright. This contention may be disposed of briefly. Section 1021 of the Probate Code of California provides:

"§ 1021. *Decree of distribution.* In its decree, the court must name the persons and the proportions or parts to which each is entitled, and such persons may [fol. 31] demand, sue for, and recover their respective shares from the executor or administrator, of any person having the same in possession. Such order or decree, when it becomes final, is conclusive as to the rights of heirs, devisees and legatees."

The California courts have consistently held that one who claims as a stranger to the estate or adversely to the estate rather than as an heir, devisee or legatee, will not be bound by a decree of distribution since the jurisdiction of the probate court is limited to rights granted in privity with the estate and does not extend to the rights or titles of adverse claimants. *Estate of King*, 199 Cal. 113; *Estate of Cropper*, 83 Cal. App. (2d) 105; *Estate of Kurt*, 83 Cal. App. (2d) 681.

Plaintiff's claim is based on an assignment executed during the author's lifetime. As such, the claim is one adverse to the estate under the California cases just cited. Plaintiff does not claim as an heir, devisee or legatee and the California probate decree does not constitute a binding adjudication of its rights.

Determination of rights of the parties here must rest on the effect to be given to Section 24 of the Copyright Act. The language of that section makes no reference to an assignment by an author of renewal rights which might accrue in the future. Until the Supreme Court resolved the question in *Fred Fisher Music Co. v. M. Witmark & Sons*, *supra*, it was far from clear that the author could, prior to the last year of the original term, make any valid assignment at all of his renewal rights. But even though

the validity of such assignments, if the author remains alive, has been established, it remains to be determined whether an assignee acquires a vested interest in the renewal rights or merely an interest contingent on the author's survival until commencement of the twenty-eighth year of the original term when his renewal rights first accrue.

[fol. 32] The statute provides that if the author is not alive during the last year of the original term, designated persons, viz., the widow and children, executor, or next of kin, in the order named, may apply for renewal in the author's stead. Defendant contends that since the designated persons, including the executor, derive their interest solely and directly from the statute, the author may not, by prior assignment, deprive any of them of the rights which the statute expressly grants them.

The rights granted by the successive Copyright Acts passed by Congress, including the presently subsisting Act of 1909, are created solely and entirely by the statute and have no existence apart from the statute. See *White-Smith Music Pub. Co. v. Goff*, 1 Cir., 187 Fed. 247, 248. Thus the right of renewal or extension after the expiration of the original term derives solely from the statute and does not exist independently of it. Ever since the enactment of the Act of February 3, 1831, C. 16, 4 Stat. 436, 439, there was, with respect to renewals or extensions, (*White-Smith Music Pub. Co. v. Goff*, *supra*, at p. 250):

" * * * an entirely new policy, completely dis severing the title, breaking up the continuance in a proper sense of the word, whatever terms might be used, and vesting an absolutely new title *eo nomine* in the persons designated."

This method persists in the present act which *eo nomine* designates the persons who may apply for a renewal as the author if living at commencement of the last year of the original term, or, if he is not living his widow and children, his executor or his next of kin successively.

The courts have frequently stated that prior to the last year of the original term the author has merely an expec-

tancy in the renewal term. *De Sylva v. Ballentine*, 351 U. S. 570, 574; *Rossiter v. Vogel*, 2 Cir., 134 F. 2d 908, 910; *Carmichael v. Mills Music, Inc.*, D.C.S.D.N.Y., 121 F. [fol. 33] Supp. 43, 45. In the light of the policy of the act with respect to renewal rights "expectancy" means that any right to renewal which the author may have is entirely contingent upon the author's survival until the commencement of the twenty-eighth year. Since this be so an author's assignment of his renewal rights *in futuro* can effectively transfer such rights to the assignee only if the author survives until the commencement of the twenty-eighth, or last, year of the original term. If the author survives he becomes vested with an absolute power to renew under the statute, and the prior contingent assignment in turn vests such renewal rights in the assignee. On the other hand, if the author fails to survive he has never become vested with any rights of renewal, such rights by statute have been vested *eo nomine* in his widow, children, executor or next of kin, as the case may be, and there is nothing which can pass by virtue of the assignment.

Plaintiff concedes that when an author fails to survive until the commencement of the last year of the original term, any prior assignment by him is void as against the widow, children and next of kin. But it contends that this is not true as to the executor, because an executor stands in the shoes of his testator and is bound to carry out any agreements entered into by the testator during his lifetime. I cannot agree with this contention. The statute does not differentiate between rights which it vests in the widow and children, the executor and the next of kin successively. There is nothing in the statute indicating that the rights of the executor are any different from those of the other persons named therein. The executor's right to renew in the event that neither the author nor his widow and children survive at the commencement of the renewal period is not a derivative right arising under general testamentary law. It is rather a right arising from the statute itself which has created the right in its own express and limited terms. Since, as has been pointed out, no such [fol. 34] right exists apart from the statute, the right can-

not be taken away unless the statute expressly so provides. This Congress has not seen fit to do.

Under the scheme of the statute the right of renewal does not follow the ordinary rules of succession. It may be noted, for example, that the widow and children are entitled to renew even though there be a will in which an executor has been designated. Moreover, while the executor may renew if there be no widow or children there is no mention whatever of an administrator should the author die intestate. In such case, absent widow and children, the renewal right is vested in the next of kin directly. This statutory scheme, in derogation of the ordinary law of succession is a further indication that the right of renewal does not belong to the author's estate by right of succession, but belongs only to the appropriate person designated in the statute, in this case the executor, who would in turn be obligated to apply for the renewal and distribute the rights so acquired in accordance with the terms of the will.

In *Danks v. Gordon*, 2 Cir. 272 Fed. 821, an administrator brought an action for infringement of a copyright renewal. The court held that the action was really one for unpaid royalties, and that an administrator has no standing to sue for infringement of a copyright renewal since he is not one of the persons entitled to renew under the statute. The action was dismissed for want of jurisdiction. The court stated at p. 825:

" * * * It will be noticed that while an executor is mentioned an administrator is not and therefore has been regarded as excluded. *White-Smith Music Publishing Co., v. Goff* (C. C.) 180 Fed. 256, 258. The right of renewal does not follow the author's estate but the renewal right is derived directly from the statute."

[fol. 35] In *Fox Film Corp. v. Knowles*, 261 U. S. 326, the author died prior to the commencement of the last year of the original copyright term, leaving no surviving widow or children, and his executor subsequently applied for the renewal copyright. The question presented there was

whether an executor could, through renewal, obtain rights which his testator never possessed during his lifetime, or whether the executor's right to apply for renewal was limited to the rare situation where the author died during the last year of the original copyright term without having made the necessary application for renewal himself. In holding that the executor's rights are the same as those of the other persons named in the statute, and that the executor's right to renew is independent of the author's rights at the time of his decease, Mr. Justice Holmes stated (261 U. S. at 329-330):

" * * * No one doubts that if Carleton had died leaving a widow she could have applied as the executor did, and executors are mentioned alongside of the widow with no suggestion in the statute that when executors are the proper persons, if anyone, to make the claim, they cannot make it whenever a widow might have made it. The next of kin come after the executors. Surely they again have the same rights that the widow would have had. The limitation is derived from a theory that the statute cannot have intended the executor to take unless he took what the testator already had. We should not have derived that notion from the section * * * "

In *Fred Fisher Music Co. v. M. Witmark & Sons, supra*, the Supreme Court, in holding that "an assignment of an author's renewal right was valid if the author survived until such right became vested in him, refers to the author's "contingent interest in the renewal" under the 1831 [vol. 36] Act prior to the commencement of the period when he could, if living, apply for renewal. (318 U. S. at p. 651.)

In the opinion of the Court of Appeals for this Circuit below in the *Fisher* case, 125 F. 2d 949; the court discussed the effect of the death of an author who had assigned his renewal interest prior to the vesting of his right to renewal and said by way of *dictum* (p. 950):

" * * * It is also apparent that the assignment here would not have cut off the rights of renewal extended

* to the widow, children, executors, or next of kin, in the event of Graff's death prior to the renewal period. * * *"

Applying the reasoning of Mr. Justice Holmes in the *Fox Film* case and of the *dictum* of the Court of Appeals of this Circuit in *Fisher* to the facts before me, I conclude that the executor has the same rights under the statute as the widow and children or next of kin. His right to renew is completely independent of what the author's rights were at the time of his decease. The fact that the author had assigned his inchoate renewal rights to the plaintiff would not have barred his widow, or children, if any, from exercising their statutory renewal rights. See *De Sylva v. Ballentine*, 351 U. S. 570, 582; *Silverman v. Sunrise Pictures Corp.*, 2 Cir., 273 Fed. 909, 913; *Shapiro, Bernstein & Co. v. Bryan*, 2 Cir., 123 F. 2d 697, 700. Under the *Fox Film* and *Fisher* cases it is clear that the executor's rights are no less than that of the widow and children or next of kin. They therefore cannot be defeated by the author's prior assignment.¹

[fol. 37] . If it be argued that it is incongruous to allow an author who has no widow or children to defeat his prior assignee by executing a will, the terms of which are in derogation of the assignment, the remedy lies with Congress which passed the statute, and not with the courts. For there is nothing in the language used by Congress which permits a contrary conclusion. The basic purpose of these provisions of the copyright statutes since the Act of 1831 is to give the reward to the author rather than the bookseller.

¹ There has been some disagreement among the text writers as to the effect of an assignment by the author upon the executor's subsequent right to renew under the statute. The following writers seem to be of the view that the author assigns only his expectancy, and that his death before the twenty-eighth year of the first term renders any previous assignment of the expectancy invalid; Ball, *Law of Copyright and Literary Property* (1944) 555-56; Spring, *Risks and Rights in Publishing, Television, Radio, Motion Pictures, Advertising and The Theater* (2d ed., revised) 95; Ladas, *International Protection of Literary and Artistic Property* (1938) 772-73. For the contrary view, see Drone on *Copyright* (1879) 327; Shafter, *Musical Copyright* (2d ed. 1939) 177.

Register of Debates, Vol. 7, Appendix CXIX. The report of the House Committee regarding Section 23 of the Act of 1909 (now Section 24) makes it plain that this was also the purpose of that section. H. Rep. 2222, 60th Cong., 2d Sess. pp. 14-15. Indeed, with respect to the renewal rights vested in the executor by the section the Committee stated:

" * * * Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or, in the absence of a will, his next of kin. It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal."

[fol. 38] The contingent interest in the renewal assigned to the plaintiff therefore never vested and was terminated by the death of the author. The renewal right then vested in the executor who could apply for and obtain a renewal which passed to the residuary legatees. They in turn could and did validly assign such rights to the defendant.

Plaintiff's motion for summary judgment is therefore denied and defendant's motion for summary judgment is granted.

However, the relief which defendant seeks by way of damages, an accounting, attorney's fees and the impounding and destruction of infringing copies, plates and moulds will require further proceedings. The order to be entered on these motions will make provision for such further proceedings as may be necessary.

Settle order on 10 days' notice.

Dated: New York, N. Y., December 31, 1957.

Frederick V. P. Bryan, U. S. D. J.

IN UNITED STATES DISTRICT COURT

ORDER AND JUDGMENT—Entered February 28, 1958

This cause came on to be heard on motion of the plaintiff and cross-motion of the defendant for summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure, and the Court having considered the pleadings in the action, and upon the stipulation of facts dated March 18, 1957, in support of the motion of the plaintiff, and the cross-motion of the defendant dated May 28, 1957, and the Court having heard oral argument and having found that there was no genuine issue as to any material fact and no controversial question of fact to be submitted to the Trial Court, and having concluded that defendant is entitled to judgment as a matter of law, and that plaintiff is not entitled to judgment as a matter of law, it is hereby

Ordered, adjudged and decreed as follows:

1. That the complaint be dismissed on the merits.
2. That the defendant have judgment on its counterclaim and for the costs of this action to be taxed in accordance with the Rules of this Court and that defendant have execution therefor.
3. That plaintiff, its agents and servants, shall be and they hereby are enjoined permanently from infringing the U. S. renewal copyright of the musical composition entitled "MOONLIGHT AND ROSES (BRING MEM'RIES OF YOU)" by Ben Black and Charles N. Daniels, in any manner, and from publishing, selling, marketing or otherwise disposing of any copies of the said musical composition or any part or parts thereof in any manner or form in the United States of America, its Territories and possessions.
4. That plaintiff, its agents and servants, be and they hereby are restrained from making any claims with respect to the ownership of the U. S. renewal copyright of [fol. 4] the musical composition entitled "MOONLIGHT AND ROSES (BRING MEM'RIES OF YOU)" and are hereby ordered to withdraw all notices of claim of ownership it has made

with respect to the U. S. renewal copyright of the musical composition entitled "MOONLIGHT AND ROSES (BRING MEM'RIES OF YOU)", including but not limited to notices and demands heretofore made upon the American Society of Composers, Authors and Publishers, and Harry Fox, agent and trustee.

5. That any and all monies accrued on account of the U. S. renewal copyright of the musical composition entitled "MOONLIGHT AND ROSES (BRING MEM'RIES OF YOU)" withheld by said American Society of Composers, Authors and Publishers and said Harry Fox, agent and trustee, because of the claim of defendant to ownership of an interest therein shall be paid to defendant.

6. That this order when entered shall be deemed the judgment of the Court.

7. That the enforcement of this order is hereby stayed pending the determination of the appeal herein to the Circuit Court.

8. That the posting of any and all bonds in connection with said appeal having been waived by defendant is hereby dispensed with.

Dated: New York N. Y., February 27, 1958

Frederick V. P. Bryan, U. S. D. J.

Judgment Entered: February 28, 1958

Herbert A. Charlson, Clerk.

[fol. 41]

IN UNITED STATES DISTRICT COURT

PLAINTIFF'S NOTICE OF APPEAL—Filed March 11, 1958

Notice is hereby given that Miller Music Corporation, plaintiff above named, hereby appeals to the United States Court of Appeals for the Second Circuit from the order and judgment, made on February 27, 1958 and entered in this action on February 28, 1958, granting the motion of the defendant for summary judgment dismissing the complaint on the merits and for judgment on its counterclaim.

Dated: New York, N. Y., March 10, 1958.

[fol. 54]

IN UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

No. 165—October Term, 1958.

Argued March 9, 1959

Docket No. 2, 339

MILLER MUSIC CORPORATION, Plaintiff-Appellant,

—v.—

CHARLES N. DANIELS, INC., Defendant-Appellee.

Before: Washington, Waterman and Moore, Circuit Judges.

Action for copyright infringement. Appellant and appellee each moved for summary judgment below. The defendant's motion having been granted, Southern District of New York, Bryan, J., the plaintiff appeals. Affirmed.

Abeles & Bernstein (Julian T. Abeles, of counsel), New York City, for Plaintiff-Appellant.

Lewis A. Dreyer and Jack M. Ginsberg (Lewis A. Dreyer, Jack M. Ginsberg, New York City; Milton A. Rudin, Payson Wolff, Los Angeles, Calif., of counsel), for Defendant-Appellee.

[fol. 55] OPINION—April 23, 1959

Per Curiam:

The judgment below is affirmed upon the written opinion of Judge Bryan, reported at 158 F. Supp. 188.

WASHINGTON, Circuit Judge (dissenting):

In his opinion below, Judge Bryan recognizes that it may be "incongruous to allow an author who has no widow

or children to defeat his prior assignee by executing a will, the terms of which are in derogation of the assignment * * * " 158 F. Supp. 188, 194 (S. D. N. Y. 1957). In my view, such a result is not only incongruous but without legal justification. In the present case, the will did not purport to bequeath the renewal rights. It was silent as to them. For all we know, the testator may have assumed that his prior assignment would be honored by his executor. But the reasoning of the opinion below extends to a silent will as well as to one in outright derogation of a previous assignment. I think in both cases the assignment should prevail.

Under the present Act, the original term for copyright protection is twenty-eight years, with a further term of twenty-eight years upon renewal. 17 U. S. C. §24 (1952).¹ According to the scheme of the statute, should the author die prior to the time when the renewal rights vest in him, any assignment of those rights which he had theretofore [fol. 56] made could not defeat the statutory right of the author's widow (or widower) and children to the copyright renewal. Cf. *De Sylva v. Ballentine*, 351 U. S. 570, 580 (1956). Similarly, if no widow and children survive, and the author were to leave no will, the renewal rights would vest in the next of kin. Cf. *Silverman v. Sunrise Pictures Corp.*, 290 Fed. 804 (2d Cir.), cert. denied, 262 U. S. 758 (1923). Finally, if no widow and children survive, the author nevertheless has the power to "bequeath by will the right to apply for the renewal." H. R. Rep. No. 2222, 60th Cong., 2d Sess. 15 (1909). Under such circumstances the executor is given the power to obtain the renewal. See *Fox Film Corp. v. Knowles*, 261 U. S. 326 (1923).

¹ The pertinent language is:

* * * the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright. * * *

This statutory scheme was created by Congress to protect the author and his family from the author's own improvidence. *Shapiro, Bernstein & Co. v. Bryan*, 123 F. 2d 697, 700 (2d Cir. 1941). But even though the intent of Congress was that the renewal rights in the first instance be "exclusive" in the author, and even though the statute was therefore framed so that the author "could not be deprived of that right," H. R. Rep. No. 2222, 60th Cong., 2d Sess. 14 (1909), there was certainly no intent by the Congress to set up an absolute prohibition on the power to assign the renewal rights. The author not only can assign the original copyright, see 17 U. S. C. §28 (1952), but also the renewal copyright as well, once the renewal right has vested in him, see *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U. S. 643, 645 (1943). Similarly, "an agreement to assign his renewal, made by an author in advance of the twenty-eighth year of the original term of copyright, is valid and enforceable." *Id.* at 647. Of course, it has been assumed that this broad power of assignment cannot be construed to defeat the renewal rights which vest in the widow and children or next of kin when the author [fol. 57] dies prior to the twenty-eighth year of the original copyright. See, e.g., *De Sylva v. Ballentine*, *supra* at 582. But even these renewal rights may be effectively defeated in favor of an assignee if the widow, children, and next of kin all join in the prior assignment by the author. Cf. *Tobani v. Carl Fischer, Inc.*, 263 App. Div. 503, 33 N. Y. S. 2d 294, affirmed, 289 N. Y. 727, 46 N. E. 2d 347 (1942). There can thus be no doubt that Section 24 of the Copyright Act does not create any "drastic restriction on free assignability." *M. Witmark & Sons v. Fred Fisher Music Co.*, 125 F. 2d 949, 953 (2d Cir. 1942), affirmed, 318 U. S. 642 (1943). This is especially true in light of the whole "history of judicial disapproval of restraints on assignability." 125 F. 2d at 953.

As we have noted, the statute includes the "author's executors" in the class of persons entitled to apply for renewal and extension of a copyright. But this cannot mean that Congress intended the executor to take personally and beneficially, as in the case of a widow or child. "The executor represents the person of his testator * * *" *Fox*

Film Corp. v. Knowles, 261 U. S. at 330. Therefore, he clearly is to take only in a representative and official capacity in order to prevent the copyright from lapsing and to effectuate any bequest of the renewal right which the testator was entitled to make. See *id.* at 329. For example, if the testator left no widow or child, and had not previously assigned his renewal rights, he could properly bequeath those rights to a friend, and the executor could effectuate the bequest. But the testator here had nothing in actuality to bequeath. He had assigned his renewal rights, and his next of kin had assigned theirs. In equity and fairness, the executor should be made to take all steps necessary to see that his testator's contract is carried out—[fol. 58] a contract which was clearly "valid and enforceable" under the *Fisher* case.

In contrast, the opinion below, adopted by the majority of this court, permits an injustice to be perpetrated. It also reinforces an anomaly within the present statutory scheme. Because an executor cannot take office until the author dies, he is the only interested person who cannot join in a prior assignment of renewal rights by the author, and hence—under the reasoning of the opinion below—the only person who can absolutely defeat the rights of the prior assignee. Such is the result in the present case. But it seems highly incongruous and illogical to place the executor, and the people who take under the will, in a position preferred to that of the author's widow and children. Surely this could never have been the result Congress intended. See *De Sylva v. Ballentine*, *supra* at 582; *Shapiro, Bernstein & Co. v. Bryan*, *supra* at 700.

[fol. 59]

IN. UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

Present: Hon. George T. Washington, Hon. Sterry R.
Waterman, Hon. Leonard P. Moore, Circuit Judges.

MILLER MUSIC CORPORATION, Plaintiff-Appellant,

v.

CHARLES N. DANIELS, INC., Defendant-Appellee.

Appeal from the United States District Court for the
Southern District of New York.

JUDGMENT—April 23, 1959

This cause came on to be heard on the transcript of record
from the United States District Court for the Southern
District of New York, and was argued by counsel.

On Consideration Whereof, it is now hereby ordered,
adjudged, and decreed that the judgment of said District
Court be and it hereby is affirmed, with costs to the appellee.

A. Daniel Fusaro, Clerk.

[fol. 60]

[File endorsement omitted]

[fol. 61] Clerk's Certificate to foregoing transcript (omit-
ted in printing).

[fol. 62]

SUPREME COURT OF THE UNITED STATES

No. 214—October Term, 1959.

MILLER MUSIC CORPORATION, Petitioner,

vs.

CHARLES N. DANIELS, INC.

ORDER ALLOWING CERTIORARI—October 12, 1959

The petition herein for a writ of certiorari to the United States Court of Appeals for the Second Circuit is granted.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

4

SUPREME COURT. U. S.

JUL 16 1959

JAMES R. BROWNING, Clerk

**IN THE
Supreme Court of the United States**

OCTOBER TERM 1959

No. 214

MILLER MUSIC CORPORATION,

Petitioner,

against

CHARLES N. DANIELS, INC.,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT**

**HAROLD H. CORBIN,
Attorney for Petitioner.**

**JULIAN T. ABELES,
Of Counsel.**